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Attorney Docket No. 24224-X2

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CHERUKURI et al.

Serial No.: 09/982,092

Group Art Unit: 1615

Filed: October 19, 2001

Examiner: B. Fubara

For: **ENCAPSULATION PRODUCTS FOR CONTROLLED OR EXTENDED
RELEASE**

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner of Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated January 29, 2003. The one-month shortened statutory period for response was set to expire on February 28, 2003; therefore a petition for a one-month extension of time and check therefor is being filed herewith, extending the deadline to March 29, 2003. Accordingly, this response should be considered timely filed.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-47 to a single disclosed species under 35 U.S.C. 121 and 372. As the basis for this restriction requirement, the Official Action states the following:

1. Restriction is required under 35 U.S.C. 121:

- I. Claims 1-34, drawn to extended release or controlled release, classified in class 424, subclass 457.
- II. Claims 35-47, drawn to pulsating release encapsulated product, classified in class 424, subclass 725.

2. Inventions II and I are related as extended/controlled release and pulsating release. The mechanism of action of extended/controlled release is different from the mechanism of action of pulsating release and this distinction is art recognized and capable of supporting different patents within the art.

If applicants elect group I, applicants must further elect one of the following classes of pharmaceuticals.

- a. A psychotropic and applicants must further elect one psychotropic agent from anti-anxiety therapeutic, insomnia therapeutic and anti-depressant (claims 13-16).

- b. A gastrointestinal therapeutic and applicants must further one gastrointestinal therapeutic agent from ulcer therapeutic, anti-emetic and anti-diarrheal therapeutic (claims 19-28).

- c. A migraine therapeutic.

- d. A hypertension therapeutic.

Applicants are advised that a reply to this requirement must include an identification of the therapeutic agent that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of

the other invention.

PROVISIONAL ELECTION

Applicant provisionally elects the inventive subject matter of Group I, with traverse, for prosecution at this time. Applicant respectfully submits that Group I contains claims 1-34. In addition, Applicant provisionally elects the following species, with traverse, for prosecution at this time: a psychotropic therapeutic, with the psychotropic therapeutic being an anti-depressant. Applicant respectfully submits that claims 1-13 and 16-18 read on the elected species.

TRAVERSAL

Applicant respectfully traverse the Examiner's restriction requirement.

As an initial matter, Applicants respectfully point out the identical classifications of the groups of inventions put forth by the Examiner. As such, Applicants respectfully submit that the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "**serious burden**" if a restriction were not required. See MPEP 803. Regardless of

any differences which may exist between the inventions set forth in the different groups, a complete and thorough search for the invention set forth in any one of the groups **would require searching the art areas appropriate to the other groups, especially given the identical classifications**. Since a search of each of the inventions of the groups would be coextensive, it would not be a **serious** burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims, **especially considering the identical classifications for the two groups**. Considering that the Examiner must search the generic claims, searching for the other claims would be minimally burdensome on the Examiner. Surely a search of one group will require searching the classes and subclasses of the other groups.

Accordingly, given the overlapping subject matter and classifications of the groups, examinations of all the groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at

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the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring Applicant to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing Applicant to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

CONCLUSION

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

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Respectfully submitted,

NATH & ASSOCIATES

Date:

March 28, 2003

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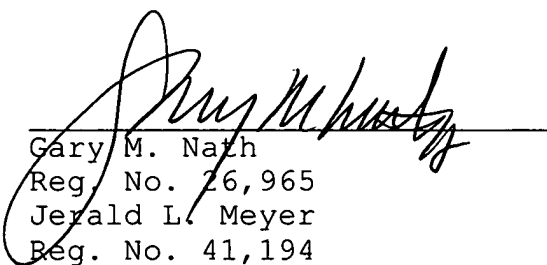
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